



Paper No. 5

FOGG SLIFER & POLGLAZE, P.A.
P.O. BOX 581009
MINNEAPOLIS, MN 55458-1009

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OFFICE OF PETITIONS

In re
James Leroy Snell
Reissue Application No. 10/005,483
Filing Date: November 9, 2001
Reissue of Patent No. 5,982,807
Original Issue Date: November 9, 1999
Attorney Docket No. 125.003USR1

DECISION REFUSING STATUS
UNDER §1.47(b)

This is in response to the petition under 37 CFR 1.47(b), filed July 5, 2002.

The petition is DISMISSED.

Rule 47 applicant is given **TWO MONTHS** from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 C.F.R. §1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. **Failure to respond will result in abandonment of the application.** Any extensions of time will be governed by 37 C.F.R. §1.136(a).

The above-identified reissue application of patent No. 5,982,807 (Issued November 9, 1999) was filed on November 9, 2001, with an unexecuted reissue declaration¹; missing both the written consent of assignee with statement under 37 CFR 3.73(b), and the statutory basic filing fee; and with additional claim fees due. Accordingly, on February 8, 2002, the Office mailed a "Notice to File Missing Parts of Reissue Application," requiring the missing items, along with the surcharge under § 1.16(e) for late filing. This Notice set a two-month period for reply, with extensions of time obtainable under § 1.136(a).

Applicant replied with the instant petition under § 1.47; payment of the petition fee by check and of the late surcharge by general authorization to charge a Deposit Account; a written consent of assignee and a declaration executed by Paul A. Bernkopf, Corporate Vice President, on behalf of assignee Intersil. This reply was made timely by an accompanying petition for an extension for response within the third month (and fee). Rule 47 applicant asserts that status under § 1.47 is

¹37 CFR 1.172 (a) provides that:

A reissue oath must be signed and sworn to or declaration made by the inventor or inventors except as otherwise provided (see §§1.42, 1.43, 1.47), and must be accompanied by the written consent of all assignees, if any, owning an undivided interest in the patent, but a reissue oath may be made and sworn to or declaration made by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent. All assignees consenting to the reissue must establish their ownership interest in the patent by filing in the reissue application a submission in accordance with the provisions of §3.73(b) of this chapter.

proper because sole inventor Snell refuses to join in the application. In support thereof, applicants submitted declarations of patent attorney Paul A. Bernkopf and of paralegal Elizabeth A. Bauer. Documentary evidence establishing that the application papers were presented to inventor Snell by Federal Express on May 17, 2002 accompanied the declaration. Further paralegal Bauer specifically declared that inventor Snell had acknowledged receipt of the application papers and that by telephone on June 19, 2002 had expressly refused to sign the declaration.

A grantable petition under 37 CFR §1.47(b) requires: (1) an acceptable oath or declaration in compliance with 37 C.F.R. § 1.63 and 1.64 or 1.175; (2) the rule 47 applicant must state his or her relationship to the inventor as required by 37 C.F.R. § 1.64; (3) proof that the non-signing inventor cannot be found or reached after diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (4) the petition fee; (5) a statement of the last known address of the non-signing inventor; (6) that rule 47 applicant make out a *prima facie* case (i) that the invention has been assigned to him or her or (ii) that the inventor has agreed in writing to assign the invention to him or her or (iii) otherwise demonstrate a proprietary interest in the subject matter of the invention; and (7) rule 47 applicant must prove that the filing of the application is necessary (i) to preserve the rights of the parties or (ii) to prevent irreparable damage. See MPEP §409.03(g).

The petition included payment of the petition fee; a statement of the last known address of the non-signing inventor; a copy of the assignment of the invention to rule 47 applicant; and a statement by Attorney Mark Kelly that the filing of the reissue application is necessary to preserve the rights of the parties hereto, and that irreparable harm would result to rule 47 applicant if the petition was not granted. Attorney Kelly's statement was supported by the declaration of patent attorney Paul Bernkopf. Rule 47 applicant has thereby met requirements (4) - (7) above.

However, the petition is not grantable because requirements (1)-(3) have not been satisfied. The declaration submitted is not acceptable. A reissue declaration must comply with the requirements of § 1.63 and § 1.175. The declaration submitted only complies with § 1.63. A new declaration executed by the assignee including the title of the person signing on behalf of the assignee is required. Although rule 47 applicant has provided evidence that non-signing sole inventor Snell has refused to join in the filing of the above-identified application after having been presented with the application papers, this evidence has been rendered insufficient due to the deficiency in the declaration. It cannot be concluded that inventor Snell has refused to join in the reissue application where the wrong declaration has been presented for signature. A showing that inventor Snell has refused to join in the application after having been presented with the proper reissue declaration is required.

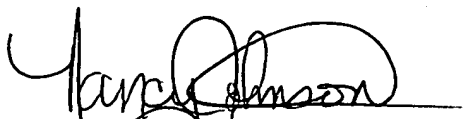
Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions
ATTN: NANCY JOHNSON

By hand: Office of Petitions
2201 South Clark Place
Crystal Plaza Four, Suite 3C23
Arlington, VA

Telephone inquiries related to this decision may be directed to the undersigned at (703) 305-0309.

A handwritten signature in black ink, appearing to read "Nancy Johnson", written over a horizontal line.

Nancy Johnson
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy